DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-5, 7-13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ito et al. (US 6,458,437), Chang et al. (US 4,485,228), and Taylor (US 4,038,228).

3. Ito discloses a heat-shrinkable polyester film comprising a polyester elastomer which is a polyester block copolymer (abstract; 211-15; 3:36-47). Wherein the polyester film is suitable as labels on PET bottles (1:4-13). The polyester block copolymer comprises high melting point crystalline polyester segments (hard segments) and low melting point soft polymer segments (soft segments). The hard segments are formed of dicarboxylic acid residues (such as terephthalic acid) and diol residues (such as ethylene glycol) (3:48-4:5). The soft segments is formed of polymers of cyclic esters (such as poly-e-caprolactone). The soft segments have melting points of 80°C or less and have a molecular weight in the range of 400-8000 (4:6-27). The soft segment is 1-90 wt% of the polyester block copolymer, accordingly the hard segment is 10-99 wt% of the polyester block copolymer (4:15-18).

4. Ito fails to disclose the claimed alicyclic non-aromatic compound (the (a) unit for the prepolymer $P^{A)}$). Hence attention is directed towards the Chang reference which explicitly discloses that terephthalic acid and tetrahydrophthalic acid (or its anhydride) are considered functional equivalents (4:49-64). Therefore, because the these compounds were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute tetrahydrophthalic acid (or its anhydride) for the terephthalic acid of Ito.

5. The combination of Ito and Chang above fail to disclose the inclusion of a transition metal salt in the film composition, as claimed. Thus attention is directed towards the Taylor reference. Taylor discloses the formation of transition metal salt compounds which improves the degradation of polymers (1:60-2:5; 3:4-13). Accordingly, it would have been obvious to one of ordinary skill in the art to include a transition metal salt in the film taught by Ito and Chang in order to form a film which is capable of non-photochemical degradation of the polymer post consumer consumption.

6. In reference to the claimed glass transition temperature of the prepolymer (P^A), it is noted that since the prior art teaches the identical chemical structures, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The burden shifts to the applicant to show an unobvious difference. Note, that because the reference does not expressly teach or address the properties of the claimed invention, does not mean that the properties are not inherently disclosed. Teaching the same compound(s) inherently discloses the corresponding properties. The references cannot possibly teach or address all of the properties, but implicitly all of the properties are present.

Response to Arguments

7. Applicant's arguments with respect to the claims (the prior art rejections) have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments and amendments with respect to the 112, first paragraph rejections have been fully considered and are persuasive. Accordingly, the 112 new matter rejection has been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAIRA HAIDER whose telephone number is (571)272-3553. The examiner can normally be reached on Monday-Friday from 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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